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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kouichirou WAKABAYASHI et al.

Group Art Unit: 2653

Application No.: 09/671,478

Examiner: A. Psitos

Filed: September 27, 2000

Docket No.: 107454

For: INFORMATION RECORDING MEDIUM RECORDING AND REPRODUCING APPARATUS THEREFOR, AND HEAD POSITIONING METHOD USING A SERVO PATTERN BEING FORMED AS MAGNETIC MARKS

**REQUEST FOR RECONSIDERATION**

**RECEIVED**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SEP 09 2004

Technology Center 2600

Sir:

In reply to the June 7, 2004 Office Action, reconsideration of the application is respectfully requested.

Claims 1-15 are pending in this application.

The Office Action rejects claims 1, 2, 4-7, 9 and 14 under 35 U.S.C. §103(a) over Patent Publication No. WO00/14733 further considered with U.S. Patent No. 5,615,065 to Cheung. WO00/14733 corresponds to U.S. Patent No. 6,560,168 to Saga et al. (hereinafter "Saga"). This rejection is respectfully traversed.

Applicants respectfully submit that Saga does not constitute prior art under any section of 35 U.S.C. §102. Saga does not qualify as prior art under 35 U.S.C. §102(e), because the International application was filed prior to November 29, 2000. According to MPEP §706.02(f)(1), a U.S. patent issued from an International application that was filed prior to November 29, 2000 has a 35 U.S.C. §102(e) prior art date as of the date of fulfillment

of the requirements of 35 U.S.C. §371(c)(1)(2)(4). The 371(c)(1)(2)(4) date for the Saga reference is December 12, 2000, which is after the September 27, 2000 filing date of this application.

WO00/14733 only qualifies as prior art under 35 U.S.C. §102(a), because its publication date of March 16, 2000 is less than one year prior to Applicants' September 27, 2000 filing date.

By virtue of the Japanese Patent Applications 11-271728 filed September 27, 1999 and 11-356857 December 16, 1999, Applicants claim an invention priority date which antedates the March 16, 2000 publication date of the WO00/14733 reference. In order to perfect this claim for priority, Applicants submit herewith Verified English Language Translations of the foreign priority documents. Because Applicants have perfected their claim for priority, Applicants are entitled to an effective U.S. filing date that antedates WO00/14733.

Accordingly, Applicants respectfully submit that neither Saga nor WO00/14733 constitute prior art, and request that the rejection of claims 1, 2, 4-7, 9 and 14 under 35 U.S.C. §103(a) be withdrawn.

The Office Actions states that "the limitations of claims 11, 12 and 14 are method claims equivalent to claims 1, 6 and 9, and are met when the above combined systems operate." To the extent that the rejection of claims 1, 6 and 9 are applicable to claims 11, 12 and 14, the rejection is traversed based on the fact that WO00/14733 is not prior art.

The Office Action rejects claim 3 under 35 U.S.C. §103(a) over WO00/14733 and Cheung, and further in view of Official Notice. The Office Action rejects claims 8 and 13 under 35 U.S.C. §103(a) over WO00/14733 and Cheung, and further in view of Figure 3 of Saga. The Office Action rejects claims 10 and 15 under 35 U.S.C. §103(a) over WO00/14733 and Cheung, and further in view of Official Notice. Applicants submit that the

Official Notice does not remedy the deficiency created by the removal of WO00/14733 as a prior art reference. Accordingly, Applicants respectfully request that the rejection of claims 3, 8, 10, 13 and 15 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-15 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Jaquelin K. Spong  
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JAO:JKS/scg

Attachments:

Verified English Translations (2)

Date: September 3, 2004

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